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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Loewenstein
Serial No. : 10/015,314
Filed : 12/11/01
Title : POKER GAME
Examiner : Rada
Art Unit : 3714

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

This document is in response to the May 16, 2006 Notice of Non-Compliant Appeal Brief.

Applicant has made all necessary amendments to the Appeal Brief, which complies with all relevant sections of the C.F.R.

Applicant notes the Appeal Brief was first filed in September 6, 2005, refiled on November 17, 2005 and refiled again January 16 2006. Applicant urges the Examiner to allow the claims for the reasons set forth in the accompanying brief or to file an opposition brief to enable the Board of Appeals to decide this matter on the merits.

Respectfully submitted,

Date: June 16, 2006


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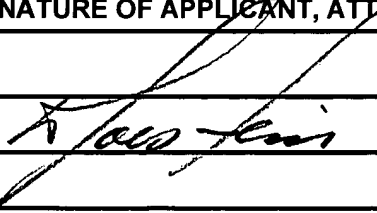
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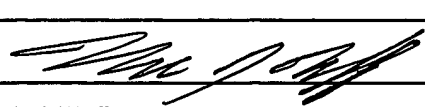
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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Date	June 14, 2006	Reg. No.	35,591

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AMENDED APPEAL BRIEF

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I. REAL PARTY IN INTEREST

The real party in interest in this appeal brief is David A. Loewenstein.

II. RELATED APPEALS AND INTERFERENCES

There are no other prior and pending appeals, interferences and judicial proceedings that may be related to, directly affect, or may be directly affected by or have a bearing on the Board's decision in the pending appeal that are known to appellant.

III. STATUS OF CLAIMS

The status of the claims is as follows:

- Claims 1-14, 16-19, 23, and 26-27 are rejected and are being appealed
- Claims 15, 20-22, and 24-25 have been withdrawn

IV. STATUS OF AMENDMENTS

The appellant filed one amendment subsequent to final rejection on September 2, 2005, in which Claim 27 was amended after the to change the word "swaps" to "exchanges," a term that has an antecedent. This amendment has not been addressed by the Examiner. No other amendments after the final rejection have been made.

V. SUMMARY OF CLAIMED SUBJECT MATTER

As explained in more detail below, the inventions at issue here are a unique set of poker games that require the player to analyze carefully multi-variant expected values necessitated by the novel combination of card exchanges and hands that share common cards. Altogether these claimed games require complex strategies and non-trivial analyses that are not disclosed or suggested in any prior art reference. Moreover, the inventions at issue solve a problem with the prior art, namely that the cited prior art game (Marks) plays too slowly for commercial applications.

The novelty, lack of motivation to combine, failure of others, and improvement over the prior art are set forth in the accompanying declaration of Tony Celona, an expert in the field with over two decades of experience, who has first-hand experience with the problems associated with the cited prior art -- but whose testimony the Examiner simply rejected without reasoned explanation.

Claim 1 discloses a novel method to play video poker where cards are dealt in a four sided diamond shape with each side of the diamond being a separate hand consisting of five cards with corner cards shared between adjacent hands.¹ After the cards are dealt, a player can exchange cards between hands which requires the player to consider novel multi-variant potential outcomes (discussed in more detail below) to determine whether, for example, the improvement of one hand offsets the worsening of another.² Because all hands are linked, the strategy used to decide a single card

¹ See page 1, lines 6-8 of Applicant's specification; page 2, lines 1-3; and in the four hands labeled A, B, C, and D in Figures 1 and 2.

² Card exchanges are disclosed on page 1, lines 10-12; page 2, lines 8-10; lines 16-20; and page 4, lines 2-3. Figure 2, 6, and 7 show illustrative card exchanges.

exchange may affect the potential outcomes all hands. Once the player has completed all exchanges, the four hands are compared to a paytable.³

The novel aspects can be further appreciated because of the greater information available to the player as compared to prior art poker games. In particular, the game can have over 12 cards dealt face-up (about 1 of 4 cards in the deck) before he must make his first decision; by comparison, in ordinary five card draw poker only 1 in 10 cards is revealed to the player. This and the related variations disclosed in dependent claims 2-10 may give the player the impression that the game is easy to beat. This is not so; the swapping feature together with multiple hands sharing corner cards inject very difficult novel and subtle strategic tradeoffs.

Claim 10 discloses an electronic apparatus for playing video poker having a visual display that shows cards represented in an n-sided closed figure with common cards on each corner.⁴ Each side of the figure is a separate five card hand⁵ with three interior cards dealt face up and corner cards dealt face down⁶. The player can then exchange interior cards among hands as disclosed in the specification for claim 1. Once

³ See page 1, lines 11-12.

⁴ See page 3, lines 5-14 disclose a video poker machine; while page 3, lines 15-22 discuss illustrative examples of 6, 8 and 10 sided closed figures. Fig 5 shows an illustrative video poker machine; and Figs. 6 and 7 show illustrative six and five sided shapes respectively.

⁵ See page 1, lines 6-8 and in Figs 1-4, 6, and 7.

⁶ See page 1, lines 9-10.

the exchanges are completed, the corner cards are turned face up, and each of the hands is compared to a payable.⁷

Claim 17 and the associated dependent claims disclose a method to play video poker in which one or more pairs of hands with five cards in each hand are dealt.⁸ Each hand consists of three interior cards dealt face up and two end cards dealt face down.⁹ The player can then exchange interior cards among hands as disclosed in the specification for claim 1. Each hand is then compared to a payable.¹⁰

Claim 23 discloses a four step method for playing a video poker game in which sixteen cards are dealt in a four sided diamond shape where each side is a separate five card hand with three interior cards and two corner cards¹¹ A player is allowed to exchange cards from one hand to another hand¹² Each hand is then compared to a payable, and the player is paid accordingly.¹³

Claim 26 discloses a method to play video poker in which cards are dealt in a four sided diamond shape where each side is a separate five card hand with three interior cards and two corner cards¹⁴. A player can exchange cards from one hand to

⁷ See page 1, lines 11-12.

⁸ See page 2, line 13 (two coins yields two games).

⁹ See page 1, lines 9-10 and Figure 2.

¹⁰ See page 1, lines 11-12.

¹¹ See page 1, lines 6-10 and shown in Fig 1.

¹² See page 1, lines 10-12; page 2, lines 8-10; lines 16-20; and page 4, lines 2-3. Figure 2, 6, and 7 show illustrative exchanges.

¹³ See page 1, lines 11-12.

¹⁴ See page 1, lines 6-10 and Figure 1.

another¹⁵ and can perform additional exchanges of the previously exchanged cards to a third or fourth hand¹⁶. After the player has completed all exchanges, the hands are compared to a payable.¹⁷

Claim 27 discloses a method to play video poker in which cards are dealt in a four sided diamond shape where each side is a separate five card hand with three interior and two corner cards.¹⁸ A player can perform a limited number of card exchanges.¹⁹ Then, each of the four hands is compared to a payable.²⁰

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner made a host of improper rejections including one made impermissibly for the first time in the Final Office Action.

There were essentially two grounds of rejection, one under section 103 and the other under various paragraphs of section 112. None is well taken.

¹⁵ See page 1, lines 10-12; page 2, lines 8-10; lines 16-20; and page 4, lines 2-3. Figures 2, 6, and 7 show illustrative exchanges.

¹⁶ See page 3, lines 1-2 (“[f]or each additional payment, the player would be entitled to additional exchanges.”), see also page 4, lines 2-3 (“one coin could be required for each exchange”).

¹⁷ See page 1, lines 11-12.

¹⁸ See page 1, lines 6-10 and Figure 1.

¹⁹ See page 1, lines 10-12 and page 2, lines 8-10. See also Figures 2, 6, and 7 which show illustrative exchanges.

²⁰ See page 1, lines 11-12.

A. The Examiner's Improper Obviousness Rejections

All but claims 26 and 27 were rejected on the grounds on obviousness based in whole or in part on the improper combination of the Marks (U.S. Patent No. 5,882,260) and Wood (U.S. Patent No. 6,471,587), as the table below shows:

<u>Claims</u>	<u>Basis of Rejection</u>
1-6, 8-12, 14, 17-19 and 23	Combination of Marks and Wood
7 and 13	Combination of Marks, Wood and Garrod
16	Combination of Marks, Wood and Wächtler

As explained below, the examiner assumed the conclusion without undertaking the Federal Circuit's mandated rigorous obviousness analysis. He engaged in faulty hindsight reconstruction, failed to identify a proper motivation to combine and ignored persuasive evidence of secondary considerations proving the inventions at issues would not have been obvious to a person of ordinary skill.

1. The Improper Combination of Marks in View of Wood

The Examiner incorrectly concluded that Claims 1-6, 8-12, 14, 17-19, and 23 would have been obvious based on the combination of Marks and Wood. The Examiner stated that Marks, an unsuccessful prior art card game that required cards to be dealt laboriously one-at-a-time, disclosed the inventions of claims 1, 10, 17, 19, and 23, but he admitted Marks did not disclose exchanging cards as recited in the claims. He never explained how the Marks failed prior art game could have been modified to incorporate card exchanges, but nevertheless asserted Woods would somehow have been combined with Marks, by the conventional thinking person of ordinary skill, to arrive at

the claimed inventions. The only, and plainly ambiguous, alleged motivation to combine these disparate references was the Examiner's conclusory remark that the combination of incompatible card games would "provide game players a chance to modify their poker hands to increase their chances for better reward." As discussed below, this is not a legally cognizable motivation to combine -- and the resulting combination would have required an entire reconstruction of the prior art games, or would have resulted in a combination of games that would not have worked. This is plainly not a legally permissible combination of the prior art.

2. The Improper Combination of
 Marks, Wood, and Garrod

Claims 7 and 13 were rejected as being allegedly being obvious over a three-reference combination: Marks, Wood and Garrod (U.S. Patent No. 6,206,373). The Examiner stated that incorporating Garrod's teaching of a wild card with Marks and Wood would "provide game players a chance at an increased outcome." Again, this is not a specific motivation to combine these far-flung references. There are myriad ways of "increase[ing an] outcome" that cannot possibly suggest to the conventional thinking person of ordinary skill to combine the three references at issue.

Indeed, in conventional poker when a player replaces his cards, he is trying to "increase[his] outcome."

3. The Improper Combination of
 Marks, Wood, and Wachtler

Claim 16 was rejected as allegedly obvious over the combination of Marks, Wood and Wachtler (U.S. Patent No. 3,876,208). Again, the Examiner assumed

the conclusion and failed to identify and particularized motivation to combine these references, and made an unworkable combination.

B. The Examiner's Improper Section 112 Rejections

Claims 26 and 27 were newly added just before the last office action. They were not rejected on the basis of any prior art, and presumably the Examiner concedes they are valid in view of the prior art.

1. Section 112, ¶ 1 - Exchange of Non-opposed Cards

Claim 26 was improperly rejected under to 35 U.S.C. § 112, ¶ 1 and ¶ 2 because the Examiner incorrectly thought there was no disclosure for for exchanging cards from anything other than opposite sides of the figure and no disclosure for additional exchanges of previously exchanged cards. As stated above, the specification does disclose additional exchanges, and Figure 7 plainly shows card exchanges from non-opposite sides of the figure. The Examiner is simply wrong. Moreover, the Examiner is wrong on the law by demanding a carbon copy of each claim in the specification.

2. Section 112, ¶ 2- Indefinite Subject Matter

The Examiner also incorrectly rejected Claim 26 under 35 U.S.C. § 112, ¶ 2. He simply asserted, without any explanation, the claim allegedly was indefinite. As discussed below, under the proper legal analysis, claim 26 certainly complies with section 112, ¶ 2.

3. Section 112, ¶ 2 - Insufficient Antecedent for “Swaps”

Claim 27 was rejected under 35 U.S.C. § 112, ¶ 2 for insufficient antecedent basis for the limitation “the swaps.”

Claim 27 had been amended well prior to this Appeal to make that rejection moot.

C. The Improper Objection Under 37 CFR 1.83(a)

After 3 ½ years of prosecution, the Examiner for the first time in the Final Office Action objected to the drawings under 37 CFR 1.83(a) (which requires drawings only “where necessary for the understanding of the subject matter sought to be patented ...”) (emphasis added) stating that a flowchart of method claims 1-9, 17-19, 23, and 26-27 must be added at this late stage of the prosecution, or the features cancelled from the claims. Clearly, the claimed inventions (which the Examiner argues would have been obvious) are sufficiently understandable so that no flow chart is “necessary” to understand the subject matter.

VII. ARGUMENT

A. The Improper Obviousness Rejection

Claims 1-6, 8-12, 14, 17-19, and 23. All section 103(a) rejections have relied on the combination of the Marks and Wood patents. The subsequent sections address the further additions of Garrod and Wachtler as applied to several dependent claims.

The alleged motivation to combine Marks and Wood the Examiner identified was:

“it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Marks to include exchanging cards from one hand to another as taught by Wood to provide game players a chance to modify their poker had [sic] to increase their chances for a better reward.” (page 5).

In an effort to counter Applicant’s showing that there was no motivation to combine these two references, the Examiner stated that (pages 8 - 9):

“the suggestion to combine can be found in the reference to Wood et al (US 6,471,587). Marks et al (US 5,882,260) disclosed all the claimed limitations except for exchanging cards. Wood et al was used to teach the feature of exchanging cards.”

This “motivation” is simply assuming the conclusion. The motivation supposedly exists, according to the Examiner, because individual claim elements allegedly exist in the prior art. That quite obviously is not a legally cognizable “clear and particular, [motivation to combine] supported by actual evidence,”²¹ that the Federal Circuit has held is critically important in “less technologically complex inventions.”²² The rejections, therefore, are inconsistent with a long line of Federal Circuit jurisprudence. (See infra, pp. 30 - 33).

Simply put: there was no motivation to combine Marks and Wood that a person of ordinary skill in the art, who thinks along conventional lines, and does not seek to innovate,²³ would have discerned.

²¹ Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F. 3d 1313, 1334 (Fed. Cir. 2002) (emphasis added).

²² In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999).

²³ Std. Oil v. Am. Cyanamid Co., 774 F. 2d 448, 454 (Fed. Cir. 1985):

“A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive, systematic research or by extraordinary insights, it makes no difference which.”

The Examiner seems to be under the misimpression that the inherent strategic decisions that are integral to the claimed inventions are irrelevant to the consideration of obviousness. (See Final Office Action pp. 9-10). That conclusion is inconsistent with the Federal Circuit's decisions in a number of cases, including Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261 (Fed. Cir. 1986) (which involved a patent to the "Rubik's cube" puzzle; see infra, pp. 24 - 27).

The Examiner has oversimplified the creative contribution of Applicant's games, which like virtually all video poker games are based on a standard 52-card deck with 13 ranks, four suits (jokers, of course could be added), and has used an impermissible piecemeal approach to reach his conclusion.

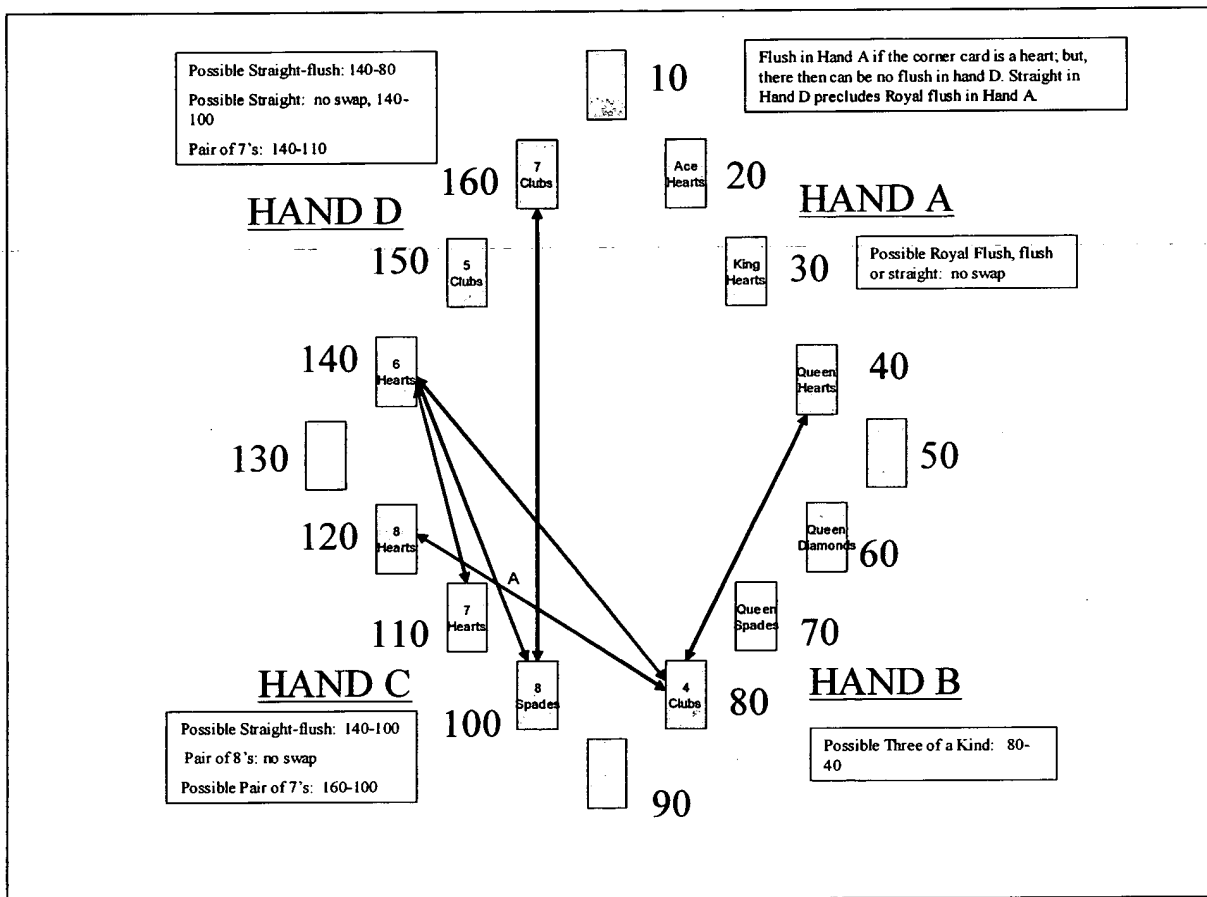
1. Applicant's Invention

Applicant's novel approach adds an entirely new set of strategies to video poker games because common cards link the player's hands, and swapping cards can improve one hand while simultaneously making another hand worse. No other card game has these unique properties, and nothing in the prior art would have suggested these innovations to a person of ordinary skill in the art.

These statements are supported by the Declaration of Mr. Tony Celona (Celona ¶19), an expert in the gaming industry with 24 years of experience, currently Vice President of Video Gaming Operations and Marketing at Yonkers Raceway, and responsible for installing 5,500 video gaming terminals at that location. (Celona Dec. ¶¶ 1 and 5). Previously, Mr. Celona was Vice President, Slot Operations for Foxwoods Casino. (Celona Dec. ¶ 3). At Foxwoods, Mr. Celona was responsible for over 7,000 video slot machines. (Celona Dec. ¶ 3). Prior to Foxwoods he was Vice President of

Slot Operations at Trump Taj Mahal Casino in Atlantic City and was responsible for 3,800 slot games. (Celona Dec. ¶ 4). Mr. Celona is also a patentee in the gaming field (U.S. Patent No. 5,564,700).

An illustration of Applicant's game follows: if the player were dealt the hands as shown below, he would be required to consider entirely new analytic strategies to solve problems that did not exist in any prior art game, and thus would be playing a game that never existed before; nor were there any suggestions to create such a game.



In this game, the player must address complex, multi-variant decisions.

Hand A has several potential high paying hands: royal flush, straight flush, straight and

flush. If the player exchanges the Queen from Hand A (card 40) with the 4 from Hand B (card 80), he will have a sure three of a kind in Hand B (three queens), but he will forego the potential very high payout from the royal flush, etc. in Hand A. For one possible payable, used in video poker games, the player must decide if he prefers his chance of getting an 800 to 1 payout on the royal flush and leave the cards the way they are, or if he should exchange cards and forego the sure three of a kind payout of 3 to 1 (but keep the 2 to 1 payout for the pair of Queens in Hand B).

Hand D has several possible straights (3, 4, 5, 6, 7; 4, 5, 6, 7, 8; or 5, 6, 7, 8, 9). But, because two 8's and a 4 have already been dealt (cards 100 and 120 and 80) the probability of completing a straight (i.e., 4, 5, 6, 7, 8) is diminished. Thus, the player must decide whether to swap card 100 (8 of spades) for card 140 (6 of hearts), making the straight in Hand D difficult, but making possible for a flush in Hand C (all Hearts). Alternatively, the player could swap cards 140 and 110, giving him a pair of 7's in Hand D and a pair of 8's in Hand C. With two pairs, his odds of getting a paying three of a kind, or possibly a full house are increased, but are they greater than the expected pay off of the previous strategy? These are only a few of the potential card exchanges.

Applicant hopes to be able to show the Board a simulation of the games on a laptop computer at the oral hearing to enable it to understand better the complexities of the games and the differences from the prior art.

2. The Failed Prior Art Marks Game

In addition to being an expert in the field of gaming, Mr. Celona has personal knowledge of the shortcomings of the prior art Marks game. Mr. Celona played and installed in a casino a game which was called "Big E" that was based on Marks'

disclosure in the 5,882,260 patent (a primary reference the Examiner relied on). (Celona Dec. ¶ 8).

Despite Mr. Celona's well-established and extremely relevant credentials, the Examiner improperly brushed aside his testimony with a terse one-sentence statement that is inconsistent with the prevailing law:

"The mere opinion of the [sic] Mr. Celona's commercial knowledge, business experience and success in games does not provide grounds in the determination of non-obviousness." (Page 8).

The MPEP, the Federal Circuit and the Supreme Court disagree.

MPEP sections 2141 and 716.01, which rely on a series of Federal Circuit cases states "Objective Evidence Must Be Considered."

Section 716 states: "Affidavits or declarations when timely presented containing evidence of ... failure of others ... must be considered by the Examiner in determining the issue of obviousness of the claims for patentability ..."

The Federal Circuit, citing the Supreme Court in Graham v. John Deere, 383 U.S. 1, 35-36 (1966), requires evaluation of "highly probative" secondary considerations:

"In Graham the Supreme Court explained that the public and commercial response to an invention is a factor to be considered in determining obviousness, and is entitled to fair weight. The so-called 'secondary considerations' provide evidence of how the patented device is viewed by the interested public: not the inventor, but persons concerned with the product in the objective arena of the marketplace. In this case the considerations of commercial success, licensing activity, and copying were markedly prevalent, and were not disputed. Such aspects may be highly probative of the issue of nonobviousness. ...

Indeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decisionmaker remains in doubt after reviewing the art."

Citations omitted; emphasis added.

Despite these unvarying admonitions, the Examiner ignored Mr. Celona's testimony that, among other things, the Marks game was an abject failure (Celona Dec. ¶ 8) -- i.e., unmistakable evidence of failure of others.

Indeed, the Examiner reached a completely unsupported conclusion -- directly contradicted by Mr. Celona:

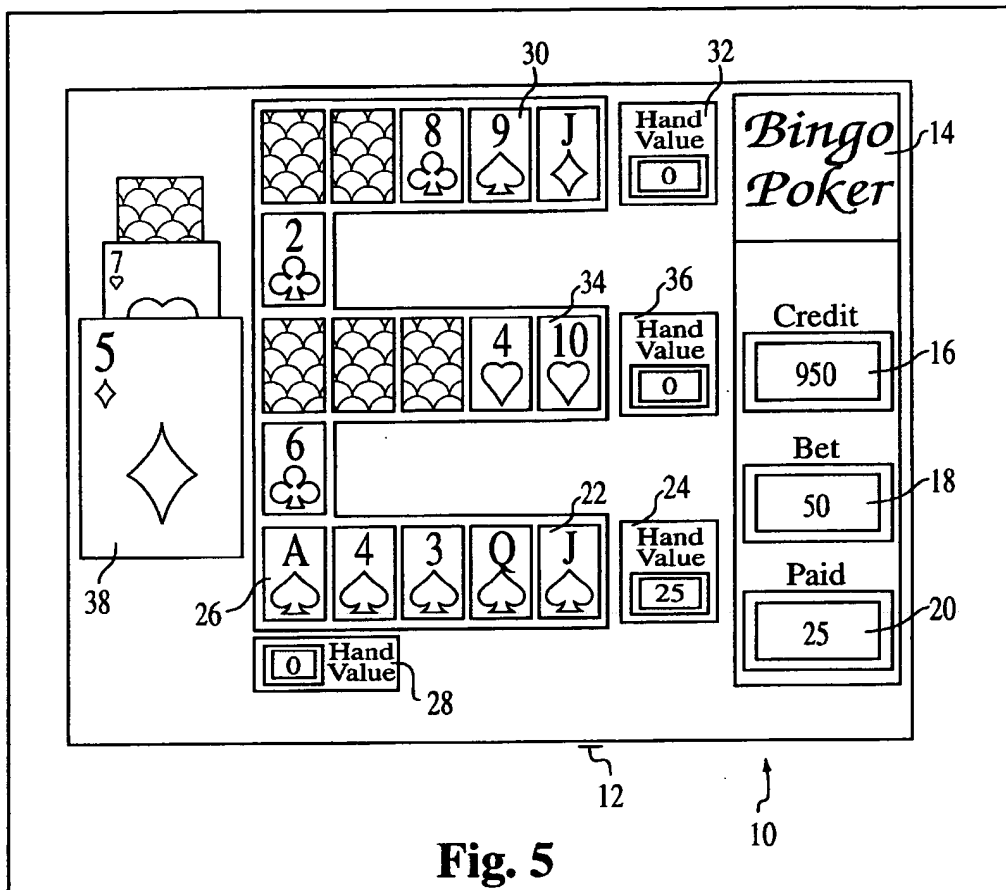
“Applicant has not disclosed that the different laid out card configuration as recited in claims 1, 5, 8-10 and 17 provides an advantage or solves a stated problem.” (Page 6, ¶ 8).

That statement is wrong. Mr. Celona testified that the claimed inventions solved a serious problem in Marks -- Marks was so slow and unworkable that made it a failure. Thus, the Examiner's decision to ignore Mr. Celona's testimony, and to reach a conclusion directly at odds with it, was a legal and factual error.

Additionally, the “problem solving” requirement must be viewed in context. This is a game. Games are built for enjoyment and possibly competition. “Problem solving”, as the term has come to be used in other technologies, is not a high priority in any game, including the cited prior art, or the Rubik's Cube (see e.g., Moleculon). Cf. Moleculon at 1268 (“What we or our predecessors may have said in discussing different fact situations is not to be taken as having universal application.”).

These prior art card games, and the invention at issue, are all incremental improvements, governed by the laws of probability and statistics associated with random distribution of playing cards. In this circumstance, the Federal Circuit insists on the “rigorous application” of the requirement to show a motivation to combine which is particularly important in “less technologically complex inventions.” (Infra, p. 30).

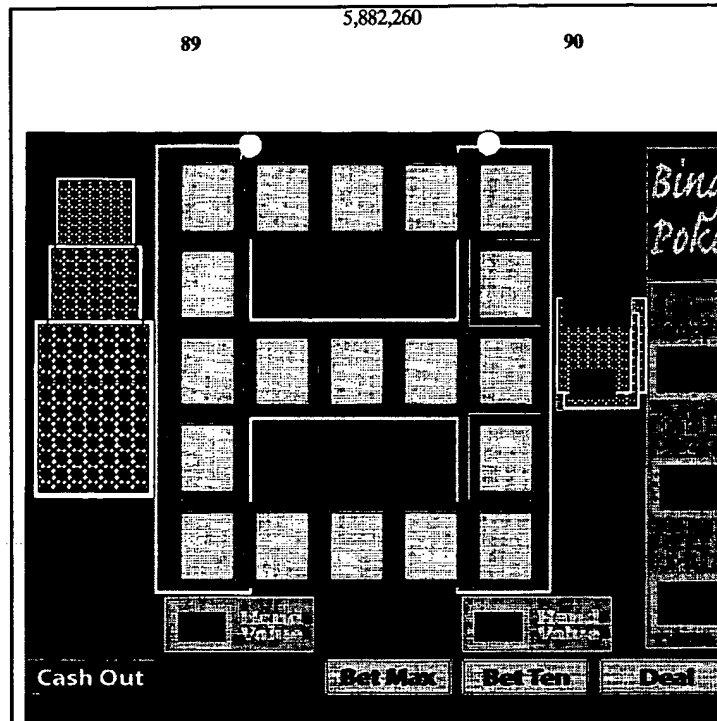
One of the embodiment shown in the Marks patent was to have a hand pattern in the shape of a capital letter “E.” (See Figure 5 from Marks below):



The disclosure of Marks’ patent, which is consistent in all his games, requires players to fill in a “hand pattern” one card at a time. (See col. 3, line 65 - col. 4, line 5; col. 6, lines 5 - 10, 27 - 31 and 53 - col. 7, line 6; col. 7, lines 39 -41; see also col. 8, lines 33 - col. 9, line 19 and Figures 15 - 27). This is a fundamental teaching of Marks -- and is a significant defect in the prior art that cannot be, but that the Examiner nevertheless, ignored. (See legal discussion *infra*, pp. 27 - 30).

For each of the 19 cards dealt in Marks’ Hand Pattern shown in columns 89 and 90 (reproduced below), which the Examiner relied on, the player must consider which of the remaining spaces he will assign that card to maximize the expected value of

the resulting hands. But, unlike Applicant's invention, he only knows the values of previously dealt cards.



The Board will quickly see one of the problems of Marks' game: the game is too slow to be commercially viable because the player must evaluate 19 cards one at a time, and decide in which of the spaces (starting with 19 empty spaces comprising five separate hands) to deposit the card. If each placement decision takes the player 5 seconds, the game will take 95 seconds. Even half that time is too much. (Celona Dec. ¶ 9). Therefore, Marks' games, which would take over a minute and a half to play, is too slow for casinos, and, for this reason, has not been successful. (Celona ¶¶ 8 - 9).

The defect in the Examiner's consideration of Marks was simply to view a single Hand Pattern of Marks' 150-column patent, and ignore the tedious and unworkable

one-at-a-time card evaluation needed to fill in a Hand Pattern – a significant and uniform teaching away. As the Federal Circuit has held repeatedly, the entire prior art reference must be considered as whole for its teaching to a person of ordinary skill in the art. (Infra, pp. 27 - 30). Any other analysis is inconsistent with the law on obviousness.

It bears emphasis that Marks' Hand Pattern that the Examiner relied on is never dealt automatically in that format. Rather, the cards are dealt one at a time, with the player determining the location of each card, until the entire pattern is complete. (Marks col. 4, lines 1-5; see also Celona Dec. ¶ 8).

As the Examiner recognized, Marks did not disclose exchanging cards. (See ¶ 8). Indeed, it is virtually impossible to envision, when or how a player would perform card exchanges while selecting cards one-at-a-time to fill in the card hand pattern as required in Marks. Exchanging cards is simply incompatible with Marks' disclosure.

Presumably, one could perform the exchanges after the Hand Pattern was filled in, but that would make the game slower, and would make a bad game worse. There can be no motivation to combine prior art references to make a worse game.

“If proposed modification would render the prior art unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” (MPEP 2143.01), citing In re Gordon, 733 F.2d 900 (Fed. Cir. 1984).

In Tec Air Inc. v. Denso Mfg Mich. Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999), the Federal Circuit made it plain that references cannot be arbitrarily combined:

“There is no suggestion to combine, however, if a reference teaches away from its combination with another source. ‘A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant or if it suggests that the line of

development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.' If when combined, the references 'would produce a seemingly inoperative device,' then they teach away from their combination."

Citations omitted; emphasis added.

As Mr. Celona testified (Celona Dec. ¶ 16), and as a matter of straightforward analysis of the prior art, adding card exchanges to Marks is unlikely to be productive and would yield an inoperative device. Therefore, there is no legally cognizable motivation to combine.

3. Wood Does Not Overcome the Shortcomings in Marks

The Examiner relied on the Wood patent to show a game that included exchanging cards. Wood shows a two handed poker game -- without common cards -- that permits the player to exchange cards -- but only in certain limited circumstances. The problem with relying on Wood is that the Examiner, again, did not rely on the teaching as a unified whole.

In Wood the player must have a "qualifying hand," which Wood explains could be a pair of 7's or better (col. 2, lines 43-46), before the exchange feature is available. Applicant's invention does not require a threshold hand before a player can exchange cards. Wood is more like a bonus game. In Wood, the player must have a winning hand before the exchange feature is available. In Applicant's invention, exchanging is always available, regardless of hand values.

The Examiner's response to Applicant's explanation of this critical defect in the prior art was "the preamble [of Wood's claim] has the word comprising. Since the word comprising is open-ended language the claim does not preclude from having a

qualifier or not [sic].” Here, the Examiner is confusing the unambiguous teaching of the prior art with the prior art patent’s claim structure. Applicant knows of no legal authority that supports the view that a claim’s common terminology (i.e., use of “comprising”) somehow overcomes the specification’s single and distinct disclosure. If this were the law, and it is not, a prior art patent could mean almost anything because of the frequent use of the term “comprising” in claim language (in patents of all types) would make all disclosures “open-ended”.

The Examiner also ignored Wood’s lack of any guidance or suggestion to combine its layout with Marks as well as Mr. Celona’s expert opinion stating the same. (Celona Dec. ¶ 13). Furthermore, neither Wood nor Marks includes revealing the identity of some of the cards at the end of play as in Applicant’s claims 2 and 18. In the games of claims 2 and 18, the corner cards are not revealed until after the card exchanges, making the complexion of the game entirely different from the prior art. That is, exchanges in Applicant’s games are made with imperfect knowledge. In Wood, all 10 cards are visible (i.e., perfect knowledge).

Wood does not add anything to the omissions in Marks. Wood does not address the complex strategies and decisions the player faces in Applicant’s inventions.

In Wood there are no common cards. There is also no teaching in Wood that would allow a person skilled in the art to add common cards to the two separate five-card hand arrangements. (Celona Dec. ¶ 15). It is altogether unclear, without resorting to impermissible hindsight, how -- or why -- one of ordinary skill in the art would modify Wood to have common cards. See e.g., (Celona Dec. ¶ 17).

As Mr. Celona testified, a person of ordinary skill in the art would not have thought to combine the Wood game with Marks. (Celona Dec. ¶ 14). There is no contrary evidence.

4. The Applicant's Inventions Would Not Have Been Obvious To A Person Of Ordinary Skill In The Art

a. The Applicant's Invention Must Be Considered As A WHOLE

The law is well settled, inventions must be considered in their entirety; that is, they cannot be dissected into their constituent parts and then matched piece-by-piece with the prior art:

“Focusing on the obviousness of substitutions and differences instead of on the invention as a whole, as the district court did in frequently describing the claimed invention as the mere substitution of monoclonal for polyclonal antibodies in a sandwich assay, was a legally improper way to simplify the difficult determination of obviousness.”

Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F. 2d 1367, 1383 (Fed. Cir. 1986).

Unfortunately, this is what the Examiner did here. He looked for a hand pattern that resembled Applicant's, and found card exchanges in Wood. But, he ignored the teaching of Marks, Wood and Mr. Celona's testimony.

The rock-solid rule is that the claimed invention as a whole must be compared to the prior art. As the Federal Circuit held in Ruiz v. A.B. Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000) (emphasis added):

“The ‘as a whole’ instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.”

Accord, Abbott Laboratories v. Syntrol Bioresearch, Inc., 334 F. 3d 1343, 1357 (Fed. Cir. 2003) (“Knowledge in the prior art of every element of a patent claim, however, is not of itself sufficient to render claim [sic] obvious.”); see also, In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1990). (“[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggests the desirability of the modification .” Citing Gordon at 902)).

The Examiner did precisely what the Federal Circuit has held, repeatedly, was in error. He dissected each claim, found a certain claim element in the prior art (or so he contends), then moved on to the next claim element seriatim, and ultimately concluded the inventions would have been obvious. That is a legal error.

More importantly, the Examiner ignored the MPEP, relying on CCPA precedent that required him to consider inherent properties of the claimed invention, like the complex, novel strategies used in Applicant’s inventions:

“In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question ... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification. . . it is this invention *as a whole*, and not some part of it, which must be obvious under 35 U.S.C. 103.”

In re Antonie, 559 F.2d 618, 619 (C.C.P.A. 1977); accord MPEP § 2141.02 (underline added).

Very recently, the Federal Circuit held reading claims in light of the specification required the claims to include inherent characteristics.

“We do not think that to construe the ‘floatation units’ as hollow is importing a limitation into the claims when the specification makes clear that hollowness is an inherent characteristic of the ‘floatation units’ in the claimed invention.”

Ocean Innovations, Inc. v. Jet Dock Systems, Inc., 2005 U.S. App. LEXIS 17775 (Fed. Cir. August 19, 2005).

Without considering the inherent, but significant differences between the claimed inventions and the prior art, the Examiner's conclusion is unsupportable.

Although the cards themselves are old, the different strategic decisions required to play Applicant's inventions (which for the most part is what all new poker game and card-game patents are about) are entirely new. These "properties of the subject matter which are inherent ... *and* are disclosed in the specification" are, because of the combination of an innovative layout and card exchanges, entirely novel and require new strategies and player decisions that have never been disclosed before.

Although a player's strategies and thought processes cannot be patented, the games that permit (or require) these strategies can be; these strategies are intrinsically interwoven in the claimed inventions are integral to, and an "inherent" part of, Applicant's inventions.

Applicant knows of no way to claim what could be hundreds of thousands (or more) different playing strategies, claims the Examiner appears to insist on.

In Moleculon 793 F.2d 1261, the Federal Circuit sustained the validity of a patent directed to the puzzle commonly called the "Rubik's Cube" over attacks to its validity based on obviousness, similar to those here, and under 35 U.S.C. §§ 112 and 101. In that case, the Federal Circuit affirmed the District Court's claim interpretation that certain features of the puzzle were inherently part of the claimed inventions:

It is plain from the specifications of the '201 patent that the user is to rotate sets of cube pieces about three axes in order to solve the puzzle. Not only are three axes an inherent feature of the 2 x 2 x 2 cube described in the specifications, but there

are explicit references to these three axes or the three corresponding coordinate planes in every part of the patent, from the abstract to the drawings. . . .

Claim 3 clearly can be read to contemplate rotation about three axes . . . This seems to be a reasonable interpretation of the words of the claim, and is clearly consonant with the implications of the rest of the patent and the intent of the patentee.”

793 F.2d at 1269 (emphasis added).

The Federal Circuit further held:

[T]he trial court correctly ascertained the true meaning of the claim by interpreting the claim language (e.g., ‘a first axis,’ ‘a second axis’) in light of the specification and the patent as a whole.”

793 F.2d at 1269 (emphasis added).

Moreover, the infringer in Moleculon also alleged the claims were invalid because they “do not ‘teach’ anyone the complicated method of solving ... [the] puzzle.” (At 1269). Solution of that puzzle is akin to the card exchange strategies incorporated into the claimed inventions here. The Federal Circuit rejected that ground for invalidity because:

“They claim a general *approach* for solving the puzzle. As the district court correctly observed, neither the claims nor the disclosure need set forth *a particular* series of moves to solve the puzzle. Not only do the series of moves for restoring depend on how the preselected pattern was randomized, but there may be more than just one sequence of steps that will restore the preselected pattern. ”

793 F.2d at 1269 (emphasis in original).

The Court’s holding is instructive because the unclaimed “particular series of moves to solve the puzzle” is the same as the particular strategy the player must use in the claimed inventions to optimize his returns. Both are “randomized” events. When the cards are dealt, they are totally random and all the hundreds of thousands of (and perhaps

more) “particular ... moves” to “solve” the multihand card “puzzle” cannot possibility be claimed, but nevertheless make up an intrinsic part of the inventions.

The Examiner’s rejection based on his assertion that “features upon which applicant relies (i.e., the game is to [sic] slow to be commercially viable, the cards are not dealt automatically, and different strategy) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.” (pages 9-10; emphasis added). The Examiner is right as a general matter that limitations from the specification are not read into the claims -- but he is wrong when he decided not to consider the vast difference between the prior art and the claimed inventions based in part on the inventions’ inherent characteristics, including the fundamentally new strategies.

It is critically important to recognize that the arrangement of the cards in Applicant’s inventions is not the only new feature of the games, nor is the card arrangement alone, the only new feature in any of the prior art. To the extent the Examiner argues that the card arrangement alone is not patentable, that is not the appropriate test to determine patentability.

b. The Prior Art As A Whole Must Be Considered

Not only must the claimed invention be considered as a whole, but each prior art reference must also be considered in its entirety. W.L Gore & Assoc., Inc. v. Garlock, inc., 721 F.2d 1540, 1550 (Fed. Cir. 1983); see also Gordon at 902.

Therefore it is imperative that: “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed

invention.” MPEP 2141.02 (first emphasis in original); Gore at 1550; see also Gordon at 902.

With these rules in mind, it is important to consider the slow-playing one-card-at-a-time game Marks has disclosed -- the entire game -- not just one of many ways his cards are displayed.

As explained above, at the beginning of Marks’ game the player sees only the first card dealt. At the same stage in Applicant’s four-sided game (e.g. claims 1 and dependent claims, 23 and 26 -27) the player knows the identity of 12 to 16 cards (he knows all 16 cards if the corner cards are dealt face up in the four-hand version of the game (see claims 3; over a quarter of the deck); seeing all 12 face-up cards immediately gives the player some insight into the face-down corner cards, not available, and not suggested, in any prior art game.

By comparison, it is not until towards the end of Marks’ game, after 12 cards are dealt one at a time (perhaps over a minute later), that the player knows the identity of 12 cards, information the player has at the beginning of Applicant’s games.

The result is that Applicant’s invention plays faster than Marks’ game and provides critically useful information to the player to help him make informed decisions about what strategy to follow. (Celona Dec. ¶ 11). This is undisputed.

Compared to Wood, the strategy in Applicant’s invention is entirely different because in Wood all ten cards are visible and the player can exchange cards only between two hands. By contrast, in Applicant’s invention of claims 2 and 10 for example, only three of the five-card hands are visible, and there are four interconnected hands displayed. The games of these claims are far more difficult than Wood because the

player does not have all the information about each of the five cards in the hand.

Additionally, the swapping strategy in Wood is much simpler. In Wood there is only one choice; swapping from hand 1 to hand 2 versus choosing among Applicant's four hands.

Neither prior art patent suggests any way to combine the two disclosures to make a playable game. Any combination of the two would require extensive reconstruction which must be based purely on hindsight teaching from Applicant's disclosure, and would yield a useless result. (Celona Dec. ¶¶ 14 to 18).

As the MPEP make plain, this hypothetical combination cannot be done, and would never have been done by a person of ordinary skill in the art:

“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” (MPEP 2143.01 and .02); see Gordon, 733 F.3d 900.

The Examiner's proposed modification of Marks, using Wood, runs afoul of these two rules. First, the modification would make the resulting game “unsatisfactory for its intended purpose.” Second, the proposed modification entirely “change[s] the principle” of Marks. Allowing exchanges after the player makes an initial set of decisions as to card locations, renders that initial set of decisions moot or irrelevant – the decision set is a key principle of Marks. This combination, therefore cannot be done, and would not have been done by the person of ordinary skill in the art. (Celona Dec. ¶¶ 14-19).

Finally, Marks could never be used in any sensible configuration to have card exchanges. (Celona Dec. ¶ 16). In Marks, when would the swapping take place? After each card is dealt? After all 19 cards are dealt? If somehow Marks and Wood were

combined, using Marks' Hand Patterns and Woods swapping, the game would be too slow to have any commercial applicability. (Celona Dec. ¶ 16).

c. There Was No Motivation to Combine

The law is too well established to admit dispute: there would not have been a combination of the prior art unless there was an unambiguous motivation or a teaching to combine the particular references at issue.

In In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999), the Federal Circuit emphasized this critically important rule as applied to “less technologically complex inventions” (in Dembiczak, the invention was for Halloween face design put on plastic garbage bags):

“Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.’

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”

(citations omitted; emphasis added); accord, Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1334 (Fed. Cir. 2002) (“The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.” A conclusory assertion that the nature of the problem supplies the necessary motivation to combine is not a clear and particular showing. (Citation omitted; emphasis added)); Crown Operations Int’l v. Krone, 289 F.3d 1367, 1376 (Fed. Cir. 2002) (“‘Determination of obviousness cannot be

based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.” (Citations omitted)).

In W.L. Gore Associates, Inc. v. Garlock, 721 F.2d 1540, 1551 (Fed. Cir. 1983), the Federal Circuit made it crystal clear that hindsight analysis must be prevented:

“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is difficult but necessary that the decision maker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.”

Although cards, and games that laid them out in many different patterns and card exchanging were known, that fact would not have made the claimed inventions obvious to a person of ordinary skill in the art. Time and time again, the Federal Circuit has held that an assemblage of “old parts” is not in and of itself unpatentable. Ruiz, supra, 234 F. 3d at 665 (footnotes and citations omitted; emphasis added):

“Because there is ‘a general rule that combination claims can consist of combinations of old elements as well as new elements,’ ‘the notion that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, § 103.’ It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements.’

Arkie Lures Inc. v. Tackle, Inc., 119 F.3d 953, 957 (Fed. Cir. 1997)(same); In re Dembiczak, supra.

The Examiner has not pointed to any motivation to combine these dissimilar references. The closest the Examiner has come to identifying a motivation to combine is: that exchanging cards “would provide game players a chance to modify their

poker had [sic] to increase their chances for a better reward.” (Final Office Action Page 5). This generalized statement, however, is not a motivation to combine the two references, Marks and Wood, the Examiner has cited. There are an infinite number of ways to modify card games “to increase [the player’s] chances for better rewards.” The pay table could be improved; the number of cards in the deck could be reduced, bonus wheels, and bonus cards could be used; jokers and wild cards could be added; incentives could be given based on the time of day or the day of the week, etc.: this simplistic generalization is not a clear or particular motivation to combine Wood and Marks, or any of the other references. It is hindsight analysis plain and simple.

It is equally, critically important to keep firmly in mind that “the person of ordinary skill in the art is an objective legal construct presumed to think along conventional lines without undertaking to innovate, whether by systematic research or by extraordinary insights.” Life Technologies, Inc. v. Clontech Laboratories, Inc., 224 F.3d 1320, 1325 (Fed. Cir. 2000); Std. Oil Co. v. Am. Cyanamid Co., 774 F.2d 448, 454 (Fed. Cir. 1985) (“A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive, systematic research or by extraordinary insights, it makes no difference which.” (Emphasis added)). This person does not look for creative solutions, and does not consider how to completely redesign existing games to arrive at novel, challenging ones that have heretofore been unknown.

Mr. Celona testified that in his opinion, a person of ordinary skill in the art would not have been motivated to combine these references. (See Celona Dec. ¶¶ 13, 14

and 17). But, the Examiner ignored that well supported conclusion, and used the Applicant's disclosure as a blueprint for cobbling together the prior art.

The Federal Circuit's immutable rules, however, are intended to prevent the Examiner from falling into an improper hindsight analysis: that is, where the Examiner uses teaching and information in the pending application as a guide to assemble disparate prior art references. As the Federal Circuit has explained in In re Fritch 972 F.2d 1260, 1266 (1992):

“[I]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’” (Footnotes omitted).

d. Even if Combined, The References Do Not Result in The Claimed Inventions

Even if there were a motivation to combine, and there is none, the Examiner's obviousness conclusion is inconsistent with the prevailing law as enunciated in the MPEP.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP § 2143.03 (emphasis added). Citing In re Royka, 490 F. 2d 981 (CCPA 1974)).

For example, the following limitation of claim 1 would not be present in the combination of Wood and Marks, for the reasons stated above:

“dealing cards in a four sided, diamond shape, each side is a separate hand that has five cards, consisting of three interior cards and two corner cards, the corner cards are shared with two adjacent hands.”

* * *

These rules of law demonstrate Applicant's invention would not have been obvious to a person of ordinary skill in the art for at least three key reasons: (1) the differences between the references when considered as integrated wholes and the claimed inventions when considered as a whole are considerable; (2) there was absolutely no motivation to combine the references; and (3) even if these references were combined, they would not yield Applicant's invention. (Celona Dec. ¶¶ 14-19).

B. The Combination of Marks, Wood, and Garrod was Improper Claims 7 and 13. The Examiner cited Garrod for the proposition that wild cards are well known. (See discussion about claims 7 and 11, page 6). Applicant has made no claim that he invented wild cards. It is true they were well known. However, using wild cards in the novel games Applicant has claimed is a unique adaptation of these cards. Again, the claimed inventions in their entirety must be compared to the prior art, not as the Examiner has done by considering each claim element separately.

Garrod does not disclose exchanging cards, common cards or multiple hands as in Applicant's invention. Because Garrod is basically a series of single hand games, the strategy is entirely different from Applicant's. There is no suggestion in Garrod about how it could be modified to have exchanging, and there is no motivation to combine Garrod with Marks or Wood.

As explained above, the broad unfocused "motivation" to combine (to increase a player's chance for a better reward) could have lead a person to combine

Garrod and Marks -- and nothing else. The Examiner has not, and cannot explain, why a person of ordinary skill would have combined Wood with Marks instead of Marks and Garrod.

C. The Combination of Marks, Wood, and Wachtler was Improper

Claim 16. The Examiner stated that incorporating Wachtler's teaching of paying for each card exchanged with Marks and Wood would "provide game players with the opportunity to increase the chance of a bigger payout outcome."

Wächtler discloses "buying new cards" (col. 1 lines 5 – 10). Buying new cards is entirely different from paying for the right to swap existing cards. Buying new cards replaces existing cards with the expectation that the unknown new cards will be better. In the extreme case, the player can get an entirely new hand. By contrast, exchanging cards, as explained above, requires the player to redistribute existing cards. The difference is fundamental: attempting to improve a hand by acquisition (i.e., entirely new unseen cards) versus by rearranging (i.e., known cards with serious inter-relationship considerations, as explained above). Furthermore, exchanging may improve one hand while making another hand worse. There is no comparable result with replacement. Wächtler's replacement only affects a single hand and is, therefore, not comparable to an exchange. Thus, Wächtler includes an uncertain outcome from his purchase versus a known outcome in Applicant's, and each purchase affects only one hand versus Applicant's two. Wächler does not address these issues, and he does not have common cards.

It is altogether unclear why a person of ordinary skill would combine Wood's card exchanges with the addition of buying new cards. The resulting combination would be either redundant or pointless. It would be completely inconsistent with the objective of card exchanges.

D. The Examiner's Rejection Under Section 112, ¶ 1 was Wrong

Claim 26. The Examiner improperly rejected claim 26 under 35 U.S.C § 112, ¶ 1, asserting that the specification did not disclose anything but exchanging cards from the opposite sides of the figure, and the specification did not disclose "additional exchanges of the previously exchanged cards." (Final Office Action at 3, ¶ 3).

That rejection is wrong as matter of law, as explained below, and as a matter of fact. The specification describes in three place exchanging cards -- not limited to opposite side -- and Figure 7 shows two card exchanges that are not from opposite sides of the figure.

The Abstract states that the patent relates to "an innovative multi-hand poker game where cards are arranged as a polygon." Polygons, obviously include figures (like pentagons) that generally have no opposite side. The Abstract further explains:

- "The player can exchange cards from one hand with cards in another hand to improve his odds of winning."

This statement does not suggest limiting card exchanges to the hand from the opposite side of a figure.

Indeed, Figure 7 shows a pentagon shows two sets of card exchanges that are not from opposite sides of the figure. The Examiner has ignored that plain depiction.

The specification states that cards can be exchanged freely:

- “As described in more detail below, this game allows a player to play multiple games simultaneously and permits him to exchange cards from other hands to improve his odds of winning.” (Page 1, ¶ 2; emphasis added); and

- “There are a number of video poker games involving multiple hands ... but none of these games allows the payer to exchange cards from one hand to another hand.” (Page 1, ¶ 4).

None of these descriptions limit card exchanges to cards from the opposite side of a figure. Moreover, the specification indicates cards can be exchanged without limitation, and in one place expressly states that cards can be exchanged from other hands -- plural. Because a figure can have only one opposite side, this statement means the claims cannot be limited to exchanges from the opposite side.

Although three of seven figures show exchanges from opposite sides, in only one place in the text of the specification does it say: “[t]he player could then decide to swap cards from opposite sides of the diamond.” (Page 1, ¶ 2; emphasis added). Neither this conditional statement nor the figure limits the claims to swapping from opposite sides.

In Phillips v. AWH Corp., Civil Action No 03-1269, - 1286 (Fed. Cir. July 12, 2005), the Federal Circuit recently held, en banc:

“[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments. See, e.g., Nazomi Communications, Inc. v. ARM Holdings, PLC, 403 F.3d 1364, 1369 (Fed. Cir. 2005) (claims may embrace “different subject matter than is illustrated in the specific embodiments in the specification”) (Citations omitted). In

particular, we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment. (Citations omitted). That is not just because section 112 of the Patent Act requires that the claims themselves set forth the limits of the patent grant, but also because persons of ordinary skill in the art rarely would confine their definitions of terms to the exact representations depicted in the embodiments.”

Additionally, the Examiner’s rejection of multiple exchanges is inconsistent with the specification. Page 3, lines 1-2 of the specification states “[f]or each additional payment, [beyond two] the player would be entitled to additional exchanges,” and page 4, lines 2-3 states “one coin could be required for each exchange.” Both these statements demonstrate that the applicant had in his possession the concept of multiple exchanges. Recently, in Falko-Gunter Falkner v. Inglis, 2006 U.S.App LEXIS 13127 at *21 - *22 (May 26, 2006), the Federal Circuit held:

“[W]e hold, in accordance with our prior case law, that (1) examples are not necessary to support the adequacy of a written description (2) the written description standard may be met (as it is here) even where actual reduction to practice of an invention is absent: ...” As we explained in LizardTech, Inc. v. Earth Resource Mapping, PTY, Inc. [424 F.3d 1336, 1345 (Fed. Cir. 2005)]:

‘A claim will not be invalidated on *section 112* grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language. ... Placed in that context, it is unnecessary to spell out every detail of the invention in the specification; only enough must be included to convince a person of skill in the art that the inventor possessed the invention and to enable such a person to make and use the invention without undue experimentation.’” (Emphasis added).

The Federal Circuit also held in Accord, Kao Corp. v. Unilever U.S., Inc., 441 F.3d 963, 968 (Fed. Cir. 2006): “We have cautioned, however, that ‘the disclosure

as originally filed does not have to provide in haec verba support for the claimed subject matter at issue.”

The Examiner’s section 112, ¶1 rejections are inconsistent with specification’s disclosure -- and wrong as a matter of law.

Therefore, Appellant respectfully requests that the rejection be reversed.

E. The Examiner’s Rejection Under Section 112, ¶ 2 was Wrong

Claim 26. The Examiner made a conclusory one sentence rejection of claim 26 under section 112, paragraph 2 stating the claim was “indefinite for failing to particularly point out and distinctly claim the subject matter ...” the Examiner provided no explanation about why that was allegedly so.

“The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope.” In re Warmerdam, 33 F.3d 1354, 1361 (Fed. Cir. 1994), citing Amgen Inc. v. Chugai Pharmaceutical Co. Ltd., 927 F.2d 1200, 1217, 18 U.S.P.Q.2D (BNA) 1016, 1030 (Fed. Cir.), cert. denied sub nom., Genetics Inst., Inc. v. Amgen, Inc., 116 L. Ed. 2d 132, 112 S. Ct. 169 (1991) (citing Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 U.S.P.Q. (BNA) 634, 641 (Fed. Cir. 1985)).”

In Andrew Corp. v. Gabriel Electronics, Inc., 847 F.2d 819, 822 (Fed. Cir. 1988)The Federal Circuit held:

“If the claims, read in the light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.”

Quoting Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir.), cert. dismissed, 474 U.S. 976, 106 S. Ct. 340, 88 L. Ed. 2d 326 (1985); see also Exxon Research and Engineering Co. v. United States, 265 F.3d 1371 (Fed. Cir. 2001); Athletic Alternatives, Inc. v. Prince Mfg, Inc., 73 F.3d 1573, 1581 (Fed. Cir. 1996).

Claim 26 uses similar terminology as the prior claims that were not objected to under section 112, but covers a different embodiment of the claimed inventions. The Examiner has not said, nor could he, that a person of ordinary skill would not understand the claimed invention.

In Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1342 (Fed. Cir. 2003), the Federal Circuit held:

“The standard of indefiniteness is somewhat high; a claim is not indefinite merely because its scope is not ascertainable from the face of the claims. Rather, a claim is indefinite under § 112 ¶ 2 if it is ‘insolubly ambiguous, and no narrowing construction can properly be adopted.’” (Citation omitted; emphasis added).

There is no evidence whatsoever, nor could there be, that claim 26 is “insolubly ambiguous.”

Moreover, the Examiner has not rejected claim 26 over the prior art, meaning the claim is sufficiently different from the prior art to avoid any section 112, ¶ 2 issue. Amgen 927 F.2d at 1217 - 18 (to comply with section 112, ¶ 2, the claim must differentiate the prior art).

The indefiniteness rejection under section 112 is wrong as a matter of law. Therefore, Appellant respectfully requests that the rejection be reversed.

F. The Moot Section 112, ¶ 2 Rejection

Claim 27. Applicant filed an amendment after final on September 2, 2005

which replaced “the swaps” with “the exchanges” rendering this rejection moot.

G. The Improper Objection Under 37 CFR 1.83(a)

Drawings. After almost 3 1/2 years of examination, and three previous office actions, the Examiner first time (in a Final Office Action) made a rejection under 37 C.F.R. § 1.83 (a) stating that a flow chart was necessary. He also reminded Applicant that “[n]o new matter should be entered.” That rejection is doubly improper because 37 C.F.R. § 1.81 states that drawings are only required “where necessary for the understanding of the subject matter sought to be patented.” (Emphasis added). Applicant submits the subject matter is perfectly understandable without additional flowcharts. Indeed, the Examiner argues the inventions were so easy to understand that they would have been obvious to a person of ordinary skill in the art. They are not; but if the inventions would have allegedly been obvious, “the subject matter sought to be patented” is certainly understandable without a flow chart.

Furthermore, claim 23 was unchanged prior to the Final Office Action, while the other claims were simply changed from apparatus to method claims. Therefore, this “new ground of rejection” was “neither necessitated by applicant’s amendment nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)”. Consequently, as required by MPEP § 706.07(a), the office action should not have been made final.

H. Conclusion

For the foregoing reasons, the Examiner's rejections are wrong as a matter of law, and the claims are now in condition for allowance.

Respectfully submitted,



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APPENDIX I: CLAIMS

1. A method to play video poker comprising the following steps:
dealing cards in a four sided, diamond shape, each side is a separate hand that has five cards, consisting of three interior cards and two corner cards, the corner cards are shared with two adjacent hands, a player can exchange cards from one hand to another hand, after all exchanges, each of the resulting hands is compared to a payable.
2. The method to play video poker of claim 1 comprising the following steps: dealing the three interior cards in each hand face up and the corner cards face down; the player is given the opportunity to exchange interior cards; the corner cards are revealed after all exchanges, and each of the resulting hands is ~~are~~ compared to a payable after the corner cards are revealed.
3. The method of claim 1 where the three interior cards are dealt face up and the corner cards are dealt face up.
4. The method of claim 1 where the player can exchange corner cards, but the interior cards are not exchanged.
5. The method of claim 1 where a six-sided shape is used instead of a four-sided shape.
6. The method of claim 1 where an additional card is dealt that can be exchanged with one of the corner cards.
7. The method of claim 1 where an additional card is dealt that is a wild card.
8. The method of claim 1 where an eight-sided shape is used instead of a four-sided shape.

9. The method of claim 1 where a 10-sided shape is used instead of a four-sided shape.

10. An electronic apparatus used to play video poker games comprising at least one visual display, the visual display has cards represented in an n-sided closed figure, each side of the figure is a separate hand that has five cards consisting of three interior cards and two corner cards, the corner cards are shared with two adjacent hands, a player is dealt the three interior cards face up and the corner cards face down for each hand, the player then can exchange interior cards from one hand to another hand, after all exchanges, the corner cards are turned face up and each of the resulting hands is compared to a paytable.

11. The apparatus of claim 10 where the interior cards are dealt face down and the corner cards are dealt face up, and the corner cards can be exchanged.

12. The apparatus of claim 10 where all the cards are dealt face up.

13. The apparatus of claim 10 where an additional card is dealt that is used as a wild card.

14. The apparatus of claim 10 where an additional card is dealt that can be exchanged with any one of the corner cards.

16. The apparatus of claim 10 where the player must pay for each card exchange.

17. A method to play a video poker game comprising the step of dealing one or more pairs of hands with five cards in each hand, each hand consists of three interior cards and two end cards that are common to each pair of hands; the three

interior cards are dealt face up and the player can exchange interior cards between hands after all exchanges each of the resulting hands is compared to a payable.

18. The method of claim 17 where the end cards are dealt face down and are revealed after the player has exchanged cards.

19. The method of claim 17 where two pairs of hands are dealt so that each hand has three interior cards and all hands share two common end cards.

23. A method to play a video poker game that comprises the following steps:

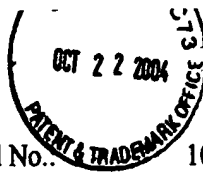
- (a) dealing cards in a four sided diamond shape, consisting of 16 cards, where each side is a separate hand that has five cards consisting of three interior cards and two corner cards, the corner cards are shared with two adjacent hands,
- (b) permitting a player to exchange cards from one hand to another hand;
- (c) after the exchanges, comparing each of the resulting hands to a payable; and
- (d) paying the player according to amounts set out in the payable for each hand.

26. A method to play video poker comprising the following steps:
dealing cards in a four sided, diamond shape, each side is a separate hand that has five cards, consisting of three interior cards and two corner cards, the corner cards are shared with two adjacent hands, a player can exchange cards from one hand to another hand, and

the player can then perform additional exchanges of the previously exchanged cards to a third or forth hand; after all exchanges, each of the resulting hands is compared to a payable.

27. A method to play video poker comprising the following steps:
dealing cards in a four sided, diamond shape, each side is a separate hand that has five cards, consisting of three interior cards and two corner cards, the corner cards are shared with two adjacent hands, a player can exchange cards from one hand to another hand, where the exchanges are limited to a predetermined number; after all exchanges, each of the resulting hands is compared to a payable.

APPENDIX II: EVIDENCE



Serial No.: 10/015,314 :
Filing Date: 12/11/2001 :
Inventor: Loewenstein :
Group Art Unit: 3714 :
Examiner Rada :
Title: Poker Game :

DECLARATION OF TONY CELONA

I, Tony Celona, declare as follows:

1. I am Vice President of Video Gaming Operations and Marketing at Yonkers Raceway, in Yonkers, New York. We are in the process of installing 5,500 video gaming terminals at that location.
2. I make this declaration in support of pending patent application 10/015,314 to David Loewenstein.
3. Prior to my position at Yonkers Raceway, I was Vice President, Slot Operations for Foxwoods Casino in Mashantucket, CT 06339-3777. Foxwoods is the largest casino in the world and has over 7,000 slot machines. Among other duties I was responsible for reviewing new games and for purchasing games at the facility.
4. Prior to Foxwoods, I was Vice President, Slot Operations at Trump Taj Mahal Casino in Atlantic City, New Jersey. Trump Casino had approximately 3,800 slot games when I left. At Trump Casino, I was responsible Slot Marketing, Slot Operations, and the Slot Host Department and in addition to reviewing new games and purchasing games for that facility.
5. Altogether I have 24 years of experience in the gaming industry.

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Examiner Rada

1

Group 3714
Filing Date 12/11/2004

6. In addition to reviewing dozens of video poker, blackjack and slot games over the years, I have invented a number of video poker games myself and have received U.S. Patent No. 5,564,700 for one game.

7. I have read Exhibit A, which I understand are the claims in pending application 10/015,314.

8. One of the games I reviewed and had the opportunity to play was a game called "Big E" that is based on Howard Marks' United States Patent No. 5,882,260, Marks' game requires players to fill in a Hand Pattern, one card at a time. Although that game was built and placed into active play it was not successful. In my opinion, this was because it simply took too long to play. Players too to much time making decisions on where to place each card.

9. Casinos need poker games where the outcome can be accomplished within 5 or 6 seconds, and Marks' game took far longer than that for each hand.

10. By contrast, in Mr. Loewenstein inventions are entirely different and the strategy is completely distinctive from Marks, as are the rules of play and the card display.

11. Mr. Loewenstein's invention plays faster and provides critically useful information to the player to help him make informed decisions about what strategy to follow. The physical location of each selected card is not a factor in the game play and therefore speeds the play considerable.

12. I have also reviewed U.S. Patent No. 6,471,587 to Wood.

13. Wood does not provide any guidance or suggestion to combine its layout and strategy with Marks.

14. In my opinion, a person of ordinary skill in the art of playing poker, thinking along conventional lines would not have thought to combine the Marks and Wood's patents.

15. Marks' one at a time game does not lend itself to swapping and Wood does not suggest a multi hand game like Applicant's where common corner cards add to the complexity and challenge.

16. Even assuming Marks and Wood were combined, it would not yield a useful result. It is also unclear to me how this combination would function. Would the swaps be done after each of Marks' cards were dealt? After the entire hand pattern was dealt? In all events, if somehow Marks and Wood were combined, using Marks' Hand Patterns and Woods swapping, the game would be too slow in my judgment to have any commercial applicability.

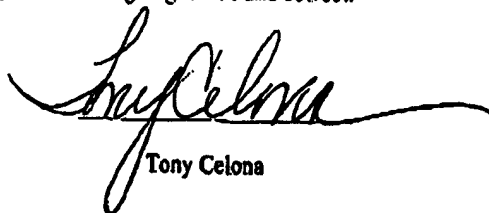
17. It is altogether unclear, from the description in the Woods and Marks patents, how one could modify Wood to have common cards, or Marks to use swapping.

18. I further conclude that even if these references were combined they would not yield the claimed inventions. For example, neither reference shows dealing cards at the outset in a diamond pattern with five cards on each side, and where the corner cards are common to adjacent hands, and swapping cards from adjacent hands.

19. In my opinion, Mr. [redacted] has followed a distinctly unique path that is inconsistent with the teaching of the prior art that would not have been obvious to a person of ordinary skill in the art.

I declare under the penalty of perjury that the foregoing is true and correct.

Dated: Oct. 18, 2004


Tony Celona

Serial No. 10/015,314
Examiner Rada

Group 3714
Filing Date 12/11/2004

APPENDIX A

1. A method to play video poker comprising the following steps:
dealing cards in a four sided, diamond shape, each side is a separate hand that has five cards, consisting of three interior cards and two corner cards, the corner cards are shared with two adjacent hands, a player can exchange cards from one hand to another hand, after all exchanges, each of the resulting hands is compared to a payable.
2. The method to play video poker of claim 1 comprising the following steps: dealing the three interior cards in each hand face up and the corner cards face down; the player is given the opportunity to exchange interior cards; the corner cards are revealed after all exchanges, and each of the resulting hands is compared to a payable after the corner cards are revealed.
3. The method of claim 1 where the three interior cards are dealt face up and the corner cards are dealt face up.
4. The method of claim 1 where the player can exchange corner cards, but the interior cards are not exchanged.
5. The method of claim 1 where a six-sided shape is used instead of a four-sided shape.
6. The method of claim 1 where an additional card is dealt that can be exchanged with one of the corner cards.
7. The method of claim 1 where an additional card is dealt that is a wild card.
8. The method of claim 1 where an eight-sided shape is used instead of a four-sided shape.

9. The method of claim 1 where a 10-sided shape is used instead of a four-sided shape.

10. An electronic apparatus used to play video poker games comprising at least one visual display, the visual display has cards represented in an n-sided closed figure, each side of the figure is a separate hand that has five cards consisting of three interior cards and two corner cards, the corner cards are shared with two adjacent hands, a player is dealt the three interior cards face up and the corner cards face down for each hand, the player then can exchange interior cards from one hand to another hand, after all exchanges, the corner cards are turned face up and each of the resulting hands is compared to a paytable.

11. The apparatus of claim 10 where the interior cards are dealt face down and the corner cards are dealt face up, and the corner cards can be exchanged.

12. The apparatus of claim 10 where all the cards are dealt face up.

13. The apparatus of claim 10 where an additional card is dealt that is used as a wild card.

14. The apparatus of claim 10 where an additional card is dealt that can be exchanged with any one of the corner cards.

16. The apparatus of claim 10 where the player must pay for each card exchange.

17. A method to play a video poker game comprising the step of dealing one or more pairs of hands with five cards in each hand, each hand consists of three interior cards and two end cards that are common to each pair of hands; the three

interior cards are dealt face up and the player can exchange interior cards between hands after all exchanges each of the resulting hands is compared to a payable.

18. The method of claim 17 where the end cards are dealt face down and are revealed after the player has exchanged cards.

19. The method of claim 17 where two pairs of hands are dealt so that each hand has three interior cards and all hands share two common end cards.

23. A method to play a video poker game that comprises the following steps:

- (a) dealing cards in a four sided diamond shape, consisting of 16 cards, where each side is a separate hand that has five cards consisting of three interior cards and two corner cards, the corner cards are shared with two adjacent hands,
- (b) permitting a player to exchange cards from one hand to another hand;
- (c) after the exchanges, comparing each of the resulting hands to a payable; and
- (d) paying the player according to amounts set out in the payable for each hand.

26. A method to play video poker comprising the following steps:
dealing cards in a four sided, diamond shape, each side is a separate hand that has five cards, consisting of three interior cards and two corner cards, the corner cards are shared with two adjacent hands, a player can exchange cards from one hand to another hand, and

the player can then perform a second exchange of the same cards; after all exchanges, each of the resulting hands is compared to a paytable.

27. A method to play video poker comprising the following steps:
dealing cards in a four sided, diamond shape, each side is a separate hand that has five cards, consisting of three interior cards and two corner cards, the corner cards are shared with two adjacent hands, a player can exchange cards from one hand to another hand, where the swaps are limited to a predetermined number; after all exchanges, each of the resulting hands is compared to a paytable.

APPENDIX III: RELATED APPEALS

There are no proceedings related to this appeal.